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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,111	05/06/1999	KENNETH JACOBS	01997.007000	3040

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Fitzpatrick Cella Haper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/306,111

Applicant(s)

JACOBS ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Claim Rejections - 35 USC 101 and 112***

1. Definitions: [from REVISED INTERIM UTILITY GUIDELINES TRAINING MATERIALS; repeated from <http://www.uspto.gov/web/menu/utility.pdf>]

“Credible Utility” - Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being “wrong”. Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based is inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore, the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests (see below).

“Specific Utility” - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a claim to a polynucleotide whose use is disclosed simply as a “gene probe” or “chromosome marker” would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

“Substantial utility” - A utility that defines a “real world” use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a “real world” context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a “substantial utility” define a “real world” context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a “real world” context of use in identifying potential candidates for preventive measures or further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a “real world” context of use and, therefore, do not define “substantial utilities”:

- A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.
- B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. ' 101.)
- C. A Method of assaying for or identifying a material that itself has no “specific and/or substantial utility”.
- D. A method of making a material that itself has no specific, substantial, and credible utility.
- E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

Note that “throw away” utilities do not meet the tests for a *specific* or *substantial* utility. For example, using transgenic mice as snake food is a utility that is neither specific (all mice could function as snake food) nor substantial (using a mouse costing tens of thousands of dollars to produce as snake food is not a “real world” context of use). Similarly, use of any protein as an animal food supplement or a shampoo ingredient are “throw away” utilities that would not pass muster as specific or substantial utilities under 35 U.S.C. ' 101. This analysis should, of course, be tempered by consideration of the context and nature of the invention. For example, if a transgenic mouse was generated with the specific provision of an enhanced

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nutrient profile, and disclosed for use as an animal food, then the test for specific and substantial *asserted* utility would be considered to be met.

A "Well established utility" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. "Well established utility" does not encompass any "throw away" utility that one can dream up for an invention or a nonspecific utility that would apply to virtually every member of a general class of materials, such as proteins or DNA. If this is the case, any product or apparatus, including perpetual motion machines, would have a "well established utility" as landfill, an amusement device, a toy, or a paper weight; any carbon containing molecule would have a "well established utility" as a fuel since it can be burned; any protein would have well established utility as a protein supplement for animal food. This is not the intention of the statute.

See also the MPEP at 2107 - 2107.02.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-5, 8, and 14-19 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The claimed nucleic acid compounds are not supported by a specific asserted utility because the disclosed uses of the nucleic acids or encoded proteins are not specific and are generally applicable to any nucleic acid and/or protein. The specification does not state a specific utility for which the claimed nucleic acids or encoded proteins may be used. While the claimed nucleic acid compounds may be useful as probes for assisting in the isolation of full-length cDNAs or genes which would be used to make protein and optionally further usage to make the corresponding antibodies, gene mapping, isolation of homologous sequences, detection of gene expression such as in Northern blot analysis, molecular weight markers, chromosomal markers, and for numerous other generic genetic engineering uses, such uses are not specific and could apply to any nucleic acid. Similarly, the encoded protein might be used for detection of expression, antibody production, Western blots, etc., but these are non-specific uses that are

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applicable to all proteins and are not particular or specific to the encoded protein of the nucleic acids being claimed.

Further, the claimed nucleic acid and/or protein compound are not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, a nucleic acid may be utilized to obtain a protein. The protein could then be used in conducting research to functionally characterize the protein. The need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case, none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acids have specific and substantial utilities. The research contemplated by applicants to characterize potential protein products, especially their biological activities, does not constitute a specific and substantial utility. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid and/or protein compounds such that another non-asserted utility would be well established for the compounds.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, 8, and 14-19 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific and substantial utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

6. Applicant's arguments filed 15 September 2003 have been fully considered but they are not persuasive. The applicants state that a prima facie showing has not been made to support the rejection. However, the utility guidelines published 05 January 2001 state:

Any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. Whenever possible, the examiner should provide documentary evidence regardless of publication date (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) to support the factual basis for the prima facie showing of no specific and substantial credible utility. If documentary evidence is not available, the examiner should specifically explain the scientific basis for his or her factual conclusions.

(a) Where the asserted utility is not specific or substantial, a prima facie showing must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. The prima facie showing must contain the following elements:

- (1) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial nor well-established;
- (2) Support for factual findings relied upon in reaching this conclusion; and
- (3) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(b) Where the asserted specific and substantial utility is not credible, a prima facie showing of no specific and substantial credible utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific and substantial utility asserted by the applicant for the claimed invention. The prima facie showing must contain the following elements:

- (1) An explanation that clearly sets forth the reasoning used in concluding that the asserted specific and substantial utility is not credible;
- (2) Support for factual findings relied upon in reaching this conclusion; and
- (3) An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.

(c) Where no specific and substantial utility is disclosed or is well-established, a prima facie showing of no specific and substantial utility need only establish that applicant has not asserted a utility and that, on the record before the examiner, there is no known well-established utility.

In this instance, it is not possible to provide documentary evidence that the claimed polynucleotides do not encode polypeptides that are useful as a polypeptide with kanadaplin

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activity. This is because the claimed polynucleotides have not been characterized in the prior art as to the capabilities of the encoded polypeptides. For the scientific reasoning of record, it is maintained that it is not credible from the evidence of record that the claimed polynucleotides encode polypeptides that have kanadaptin activity. The applicants further state that the claimed polynucleotides could be used to further study the function of prior art kanadaptin proteins, but they fail to provide evidence that the claimed polynucleotides could be used for such a purpose. The applicants point to the disclosure in the instant specification at page 197 to support their assertion of kanadaptin function, however the specification does not provide evidence as to the degree of similarity between the encoded polypeptides of the claimed polynucleotides and the sequence of known prior art kanadaptin polypeptides. The applicants state their assertion that the claimed polynucleotides encode polypeptides with kanadaptin activity is sufficient to meet the requirements of 35 U.S.C. § 101, however any assertion of utility must be credible to one of skill in the art, and absent any evidence that the assertion is true the assertion cannot be credible to one of skill in the art. As stated in the Office action mailed 23 November 2001, similarity does not automatically equate with identical function, because mere similarity of polynucleotide sequences does not equate to similarity of function of any polypeptides encoded by the polynucleotides. The applicants state that U.S. Patents have issued with claims drawn to polynucleotides that hybridize to a disclosed polynucleotide. However, it is the underlying utility of the disclosed polynucleotide that is in question here. Were a polynucleotide consisting of SEQ ID NO. 21 to have a patentable utility, there would ordinarily be patentable utility at least for polynucleotides that encoded the same polypeptide as encoded by SEQ ID NO:21. Were there a patentable utility to use SEQ ID NO:21 as a probe there would ordinarily be patentable utility for

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polynucleotides that hybridized to SEQ ID NO:21 under high stringency conditions. Here it is the underlying patentable utility of SEQ ID NO:21 itself that is in question. The applicants state that it is not clear what standards of utility are not satisfied. The claims are rejected because there is neither a specific nor a substantial utility for the claimed invention because the applicants have not provided a credible assertion of a specific and substantial utility and further because there is not a well-established utility for the claimed invention.

7. The applicants point to vague language in the Office action mailed 11 March 2003 regarding rejection of claims 1-5, 8, 14, and 16-19 under 35 U.S.C. 112, first paragraph for lack of written description. The rejection was maintained for reasons of record in the previous Office action and is reiterated below. The Office regrets the confusion the wording of the previous Office action caused the applicant.

8. Claims 1-5, 8, 14, and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The specification discloses a polynucleotide listed in SEQ ID NO: 21 and the corresponding encoded polypeptide listed in SEQ ID NO:22 and the corresponding deposited polynucleotide clone er311_20 which corresponds to a human fetal brain cDNA. SEQ ID NO: 21 and 22 and clone er311_20 meet the written description provisions of 35 USC 112, first paragraph. However, because it is not apparent that SEQ ID NO:21 and 22 and clone er311_20 comprises a complete open reading frame, claims 1-5, 8, 14, and 16-19 are directed to

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encompass gene sequences and complete cDNA sequences. Evidence that SEQ ID NO:21 is not a complete open reading frame is provided in the lineup of SEQ ID NO:21 against GenBank Version Number AK001486.1 previously made of record, which shows a human cDNA clone which comprises additional 437 nucleotides that are 5' sequences relative to the first nucleotide of SEQ ID NO:21. In addition, the specification states on page 198 that clone er311_20 encodes a polypeptide of 91 kDa, while the sequence disclosed in SEQ ID NO:22 consists of only 667 amino acids, which at an average molecular weight of 110 Da per amino acid would encode a polypeptide of only 73 kDa. The claims further encompass sequences that hybridize or are similar to SEQ ID NO: 21, corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of SEQ ID NO: 21, 22, and clone er311_20, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written

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description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993), and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of claim 5.

Therefore, only SEQ ID NO: 21, 22, and clone er311_20 but not the full breadth of the claim meets the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is variant. Applicant

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is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 703 308-4231. The examiner can normally be reached on M-F 8:30-5:00.

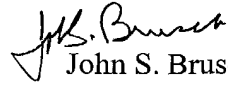
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703 308-4025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.



John S. Brusca
Primary Examiner
Art Unit 1631

jsb